

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Teresa Ancona et al.

Application No.: 10/518,729

Confirmation No.: 3186

Filed: December 20, 2004

Art Unit: 3722

For: **EMBOSSSED MARKING**

Examiner: J. V. Lewis

MS Appeal Brief - Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

Dear Sir:

Pursuant to the communication dated June 22, 2009 entitled "Notification of Non-Compliant Appeal Brief", an amended Section VII – Argument is attached.

Respectfully submitted,

By Richard M. Beck

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VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether or not claims 1, 3, 5-8 and 11 are patentable under 35 USC §103(a) over U.S. Patent Publication No. 2001/0035645 to Carides et al in view of Fukumoto US 5,779,482?

2. Whether or not claims 2 and 4 are patentable under 35 USC §103(a) over U.S. Patent Publication No. 2001/0035645 to Carides et al in view of Fukumoto US 5,779,482 and Bright US 5,753,350?

3. Whether or not claims 9 and 10 are patentable under 35 USC §103(a) over U.S. Patent Publication No. 2001/0035645 to Carides et al in view of Fukumoto US 5,779,482 and Summers US 5,566,823?

VII. ARGUMENT

Appellant respectfully submits that the subject matter of claims 1-11 is neither shown nor suggested by the prior art taken alone or in combination. Specifically, claims 1, 3, 5-8 and 11 are not rendered obvious by the combination of Carides et al US 2001/0035645 ("Carides") and Fukumoto US 5,779,482, for the reasons discussed below. Also, claims 2 and 4 are not rendered obvious by the combination of Carides, Fukumoto and Bright US 5,753,350, and claims 9-10 are not rendered obvious by Carides, Fukumoto and Summers US 5,566,823, for the reasons expressed below.

Claims 1, 3, 5-8 and 11 Are Patentable Over the Combination of Carides and Fukumoto

The primary Carides reference simply discloses a very common label assembly that includes multiple plies of flexible material some of which are transparent and some of which contain printed indicia. Presumably the invention resides in water-insoluble features, and as such Carides has little bearing on the key features of the present invention. Carides is significantly different from the present invention in that it simply comprises a label structure that includes three plies of material, namely a base ply 14, a middle ply 22 and an outside ply 26. These plies are efficiently laminated to one

another to form a single assembly 10 which may be attached to a substrate such as a bottle B. The middle ply 22 includes printed material and the base ply 14 is sealed to outer ply 26 with the printed ply therebetween. Nothing more is shown, and clearly there is no disclosure or suggestion of appellant's legible information 5 distinct from the printed information 4 and made up in the form of reliefs 51.

In the outstanding rejections the Examiner relies upon Fukumoto for appellant's claimed legible information in the form of reliefs, but there is no suggestion for adding anything to the outside or elsewhere on the label structure of Carides. Clearly the Examiner's conclusion that it would be obvious

"to provide the Fukumoto information in relief on the Carides second sheet front face, such that it is superimposed on the front face of the first sheet that bears the printed information, in order to enable both healthy persons and the visually handicapped to understand designs formed on the sheet",

is nothing more than speculation and prohibited hindsight application of appellant's own teachings, which is grossly unfair to appellant. As the Examiner is well aware, these are impermissible bases for sustaining a rejection. Without any suggestion for the formulated combination of Carides and Fukumoto, the Examiner is resorting to prohibited hindsight while improperly utilizing the present disclosure as the blue print for such profound and unsupported rearrangements of the prior art.

In determining patentability one must look to the invention as a whole as well as the features which distinguish the invention and produce the beneficial results achieved by those features. While the applied prior art generally may be somewhat analogous, such prior art does not suggest the claimed invention, and the Examiner simply has combined bits and pieces of the art without any suggestion to do so in a failed attempt to reconstruct the prior art in manner it was not intended to be reconstructed. The Examiner has failed to set forth a prima facie case of unpatentability consistent with 35 USC §103(a) and the applicable case law.

Claims 2 and 4 Are Patentable Over the Combination of Carides, Fukumoto and Bright

With respect to the subject matter of claims 2 and 4, appellant is the first to admit that embossing or other ways of deforming a substrate is old in the art, but the deformation recited in claim 2 and the surface modification recited in claims 4 are in the context of both printed information 4 and legible information 5 in the form of reliefs which cooperate with one another so that the reliefs appear to be superimposed on the printed information. Figure 4 of Bright is significant in that it shows a label 60 including printed information as well as ridges 70, but the printed information and ridges are distinct and separate from one another. They do not cooperate with one another and the ridges do not appear to be superimposed on the printed material. Moreover, Carides and Fukumoto are deficient for the reasons expressed above, and Bright does not address those deficiencies.

Claims 9 and 10 Are Patentable Over the
Combination of Carides, Fukumoto and Summers

The packaging and receptacle inner liner of claims 9 and 10 both include the material of claim 8. Summer simply discloses a toothbrush holder having Braille markings on a tray 16 found within the interior of the holder. Clearly there is no teaching or suggestion of appellant's printed information and further information in the form of reliefs both of which cooperate with one another so that the reliefs appear to be superimposed on the printed information without changing the printed information. The combination of Carides and Fukumoto falls short for the reasons discussed above. Equally significant is that there is no suggestion or motivation to alter the structure of Summers in the manner stated by the Examiner during the prosecution.

Although not controlling, it should be noted that many foreign counterparts of the present application have been granted with claims of similar scope as noted on the attached Patent Family Record Sheet for FTR0211 which is the assignee's matter number for the present application and the listed foreign counterparts.

In view of the above argument, it is submitted that claims 1-11 are indeed patentable over the prior art, and it is respectfully requested that the rejection of these claims be reversed.

VIII. CLAIMS APPENDIX

A copy of the claims involved in the present appeal is attached hereto as the Claims Appendix.


IX. EVIDENCE APPENDIX

See the attached Evidence Appendix.

X. RELATED PROCEEDINGS APPENDIX

See the attached Related Proceedings Appendix.

Respectfully submitted,

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